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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,373	03/09/2004	Alain Leas	88265-74701	4476
28765 7590 09/25/2007 WINSTON & STRAWN LLP PATENT DEPARTMENT 1700 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER THAKUR, VIREN A	
			ART UNIT 1761	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,373

Applicant(s)

LEAS ET AL.

Examiner

Viren Thakur

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-10 and 25-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-10 and 25-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. As a result of the amendment, canceling the limitation of "or part" the rejection of claim 1 under 35 U.S.C. 112, second paragraph has been withdrawn.
2. The rejections under 35 U.S.C. 103(a) not restated herein have been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 1-10, 25-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Independent claims 1, 25 and 34 recite the limitation "wherein the entire packaging sleeve is partly or entirely transparent..." It is unclear as to how an entire packaging sleeve can be partly transparent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1-4,8-10,25-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krein (US 2106893) in view of Damato (EP 0276333) and Kuehl et al. (EP0848910 A2).**

Regarding instant claims 1, 25 and 34, Krein discloses an open-ended shell made of solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection therein (Figure 10). Since the shell wall of Krein is in surface to surface contact with the packaging sleeve and since the shell is a liquefied fat based composition that solidifies when cooled, it would have been obvious that the shell would have had a smooth outer surface. The packaging sleeve (Figure 10, Item 6) protects all of the outer surface of the shell (Figure 10, Item 60) with the packaging sleeve

formed in a shape that corresponds to the desired shape of the outer surface of the shell and having an inner surface that is in contact with the outer surface of the shell. A frozen confection is in the interior volume of the shell (Figure 10, Item 65).

The claims differ from the prior art in reciting wherein the entire packaging sleeve is partly or entirely transparent.

Damato teaches using transparent plastic foil (Page 3 of 6 and Page 5 of 6) for frozen confections having a conical shape (Figure 3, Item 11). Damato further teaches that the use of transparent packaging results in a more consumer friendly packaging. That is the consumer can freely view the ice-cream in the packaging and does not need to be distracted by advertisement on the exterior of the container. Further the consumer would not have to solely rely on a photograph of the ice cream contained therein and can directly determine whether to purchase and consume the ice cream (See Page 2 of 6). Krein teaches forming a two-tone color that results in a highly attractive color effect (Page 1, Column 2, Lines 46-53) when the wrapper is removed. Nevertheless, it would have been obvious to one having ordinary skill in the art, based on the teachings of Damato, to use a transparent foil for packaging the confection of Krein for the purpose of improving the marketability of the product. Since the two-tone effect can be highly appealing to the consumer, it would have been obvious to the ordinarily skilled artisan that using a transparent packaging would have resulted in the consumer further viewing the attractive color effect prior to

purchasing. As a result the consumer would have been able to accurately inspect the product while also being further drawn to the product as a result of the color effect applied by Krein. Additionally, using the packaging of Damato also allows provides the further benefit of a liquid tight package for good protection during sale and eating with improved handling due to an intended break line.

The claims further differ from the prior art in reciting a decorative pattern design forming a smooth surface of the outer wall of the shell, said pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings.

Similar to Krein, Kuehl et al. teach molded chocolate shells intended for holding ice cream. Kuehl et al. further teach the shells including different colored layers that offer the advantage of providing attractive marbled appearance without losing adherence between the layers. The ingredients may be fat based, provide a first layer of strings and a second layer of a different color (e.g. white and plain chocolate) for the purpose of visual effects, which would result in shiny appearances. Furthermore, Kuehl et al. teach applying forced air onto the surface of the strings or dragging a probe across the surface of the strings (Page 2, Lines 10-55, Page 3, lines 3-56, Page 4, lines 4-10, Example 1), thus resulting in a smooth surface. Since Kuehl et al. teach that the coating compositions are liquid when applied and then cooled, using forced air and vibration (to remove air

bubbles) would have resulted in the smoothing of the liquid. Thus, there would have been a reasonable expectation of smoothing in the product of Kuehl et al. Kuehl et al. also teach that the visual effect can be formed as a result of the first coating being sprayed, similar to Krein and the second layer being spun onto the first coating layer. Similar to Kuehl et al., Krein also teaches providing a distinctive appearance to the product as a result of the two-tone color effect (Page 1, Column 2, Lines 46-53). Additionally, modified Krein teach using transparent packaging for the purpose of allowing the consumer to view the product disclosed therein. The two tone color effect would have result in additional appeal for the produce. Thus, it would have been obvious to include a decoration in the chocolate cone wherein a first layer of strings is supplied in white chocolate, pressed/flattened by air or a probe, a second layer of plane chocolate is applied that is shiny, as recited in instant claims 1-3, 9, 10 and 28 that maintains good definition as recited in instant claim 4, since modified Krein teach providing attractive decoration in a transparent package for the purpose of consumer appeal. As such Kuehl et al. teach that the chocolate shells provide an attractive appearance with interesting visual effects when they include a pattern design comprising a first layer of string lines made of white chocolate that are pressed or flattened via air or probes, a second layer of plain chocolate (i.e. a contrasting color), as recited in claims 1, 2, 9, 10, 28, 36 and 37, wherein the different colored layers do not separate or are capable of maintaining the pattern, as recited in instant claim 4 and that form a shell similar to Applicant that results

in a shiny appearance, as recited in instant claim 3. Thus, it would have been obvious to the skilled artisan that application of such visual effects to the shell of modified Krein would have resulted in a product having interesting visual effects that the consumer would have been able to directly view, thus providing further appeal to the consumer.

Regarding instant claims 8 and 35, Krein teaches wherein the fat based composition is chocolate (Page 5, Column 1, Lines 6-12). Regarding instant claim 26, in teaching a cone, Krein teaches portions of the cone having different circumferences. Regarding instant claim 27, Krein teaches the frozen confection extending above the top of the shell, as shown in Figure 10. Regarding instant claim 29, Krein is silent in teaching a food grade clear plastic foil, however, as discussed above, Damato teaches using a clear plastic foil having good strength and flexibility for the purpose of viewing the food product contained therein. Regarding instant claims 30 and 37, Krein teaches wherein the frozen confection constitutes an ice cream or sorbet (Page 3, Column 1, Lines 7-14).

Regarding claims 32 and 33, Krein is silent in explicitly reciting wherein the package is completed by the addition of a lid which may be transparent and which further comprises printed material on the sleeve or lid.

Damato teaches wherein the lid and the container are comprised of the same transparent plastic foil material (Page 5 of 6) and as discussed above, teach that the transparency allows the user to accurately view the product disclosed therein instead of potentially inaccurate pictures. Based on this

teaching it would have been obvious to include a lid for protecting the food product while also allowing complete viewing of the food product by the consumer. Providing a lid also would have protected the top of the product from damage during shipping and handling. Regarding instant claim 33, Damato teaches providing advertisements on the transparent packaging (Figure 3 and Page 5 of 6). As such, the addition of packaging adornments on the transparent packaging would have been obvious to one having ordinary skill in the art for the purpose of providing a mercantile package with information regarding the product, such as appealing designs or nutrition information.

Regarding instant claim 31, Krein is silent in teaching wherein the shell further comprises other inclusions such as nuts, chocolate chips, sugar confectionery particles, preserved fruit, mint chips, or biscuit crumbles. However, Kuehl et al. teach wherein the coating can comprise praline (Page 3, Lines 3-5), which is well known to the ordinarily skilled artisan to be candy patties comprising nuts. Thus, Kuehl et al. teach a coating comprising nuts as inclusions. As such it would have been obvious to use a coating that comprises inclusions, such as nuts, as taught by Kuehl et al. for the purpose of providing other distinctive flavored products that appeal to the varying consumers' tastes. Even further, Selbak (US 5425527) is relied on as further evidence of cones that contain inclusions (Column 2, Lines 56-61), depending on the particular recipe for the cone.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4, 8-10, 25-30, 32, 33 and new claims 34-36 remain provisionally rejection on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of copending Application No. 10/294764 in view of Kuehl et al. (EP 0848910 A2) and Damato (EP 276333), for the reasons cited in the prior Office Action, mailed January 29, 2007.

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10. Claim 31 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,6,16,17,20 of copending Application No. 10/294,764 in view of Kuehl et al. (EP 0848910 A2) and Damato (EP 276333), as applied to claims 1-4,8-10,25-30,32 and 33 above, further in view of Selbak (US 5425527), for the reasons cited in the prior Office Action, mailed January 29, 2007.
11. Claims 1-4, 8-10 and 25-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-9,19-27 of copending Application No. 10/385,177 in view of Kuehl et al. (EP 0848910 A2), for the reasons cited in the prior Office Action, mailed January 29, 2007.
12. Claims 1-4, 8-10,25-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5,10-14 of copending Application No. 10/800,222 in view of Kuehl et al. (EP 0848910 A2), for the reasons cited in the prior Office Action, mailed January 29, 2007.
13. Claims 32 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-5,10-14 of copending Application No. 10/800,222 in view of Kuehl et al. (US EP 0848910 A2) as applied to claims 1-4,8-10 and 25-31 above, further in view of Damato

(EP 276333), for the reasons cited in the prior Office Action, mailed January 29, 2007.

14. Claims 1-4, 8-10 and 25-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-3,7-14 of copending Application No. 10/984,914 in view of Kuehl et al. (EP 0848910 A2), for the reasons cited in the prior Office Action, mailed January 29, 2007.
15. Claims 32 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-3,7-14 of copending Application No. 10/984,914 in view of Kuehl et al. (US EP 0848910 A2) as applied to claims 1-10,25-31 above, further in view of Damato (EP 276333), for the reasons cited in the prior Office Action, mailed January 29, 2007.

Response to Arguments

16. Applicant's arguments with respect to Grigoli on pages 9, 10, 11 and 12 are moot in light of the withdrawal of the rejection made in the previous Office Action, mailed January 29, 2007.

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17. On page 9 applicant states that Kuehl does not disclose a packaging sheet for wrapping the bars and further does not teach that a chocolate shell is in complete surface to surface contact with a packaging sleeve. These arguments have been fully considered but are not deemed persuasive. The Examiner respectfully asserts that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case the Kuehl is relied on as a teaching of using decorative patterns for the purpose of providing a visually interesting product, as discussed in the rejection above.

On page 10, applicant states that the purpose of Kuehl is to impart a pleasing appearance rather than a more appealing taste. This is true, however, based on the knowledge of the ordinarily skilled artisan, a combination of a white chocolate with milk chocolate would intrinsically have resulted in a product that has a different taste. Further on page 10, applicant states that the maintenance of a smooth outer surface is not of significance to Kuehl's products. The Examiner respectfully asserts that even if a smooth outer surface is not of significance, Kuehl et al. still disclose flattening / smoothing using forced air or dragging a probe, as discussed above, and further by forming a shell using a mold with vibration to remove air bubbles, as in Example 1. Even if smoothness is incidental, by using forced air to shape the design and by using vibration to remove air bubbles in the liquid mold prior to cooling into two halves of a shell,

there would have been a reasonable expectation of success that the force of the air and the vibration would have resulted in smoothing of the surface. As another example, Kuehl teach that the confectionery product is coated with a first coating and then a second coating is added after which the product is solidified (Page 4, Lines 4-10). The design formed by the second coating can further be modified using forced air. As a result, as discussed above, this would have smoothened / flattened the surface of the shell. There would have been a reasonable expectation of success of flattening and smoothing by the ordinarily skilled artisan in light of the fact that the two coating compositions are liquid prior to cooling, and since forced air and vibration would have resulted in the settling of a liquid prior to solidifying. Regarding Kuehl not utilizing a sleeve that conforms to the outer surface of the confection, the Examiner asserts that Kuehl is not relied on for the packaging.

Regarding applicant's assertion that neither Kuehl nor Damato teach a fat based shell that has its entire surface in a pattern of at least two different colors with the outer surface of the shell in complete surface-to-surface contact with a packaging sleeve is moot in view of the new grounds of rejection. Regarding applicant's assertion that there is no suggestion or motivation to combine Kuehl with Damato since Damato is concerned with conical ice cream products and not bars has been fully considered but is not deemed persuasive. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

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some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Damato and Kuehl are secondary references teaching providing transparent packaging for the purpose of providing the customer with an accurate view of the product contained within the packaging and for providing visually interesting designs that would further have been appealing to the consumer. This is discussed in the rejection above. Regarding Damato, reference to Milligan US 1502864 shows frozen confections in the shape of a bar that use a package with a lid for ease in consuming the product. Baier US 1778479 and Becker US 2166619 are cited as further evidence of frozen confection in the shape of a bar using packaging and a lid.

18. The affidavit submitted by Alain Leas has been fully considered but is not deemed persuasive. Those statements made in the affidavit with respect to Krein, Kuehl and Damato have been addressed as discussed above and in the new grounds for rejection. Regarding Selbak, the Examiner respectfully asserts that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Selbak is relied on as a broad

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teaching that depending on the recipe for the cone (or shell) that it would have been obvious to have included nuts or inclusions for the purpose of enhancing the taste of the product.

Conclusion

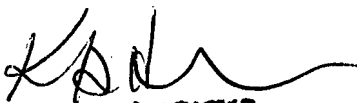
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viren Thakur whose telephone number is (571)-272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Viren Thakur
Examiner
Art Unit: 1761



KEITH HENDRICKS
PRIMARY EXAMINER